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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,252	10/12/2001	Richard W. Siegel	0094.050	9692

7590 11/10/2003

MCNEES, WALLACE & NURICK  
5 Columbia Circle  
Albany, NY 12203

EXAMINER
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KLEMANSKI, HELENE G

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 11/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

CLO 9 *lw*

**Office Action Summary**

Application No.

09/976,252

Applicant(s)

SIEGEL ET AL.

Examiner

Helene Klemanski

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1755

## DETAILED ACTION

### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

### *Response to Papers*

2. The papers filed on **February 28, 2002** (certificate of mailing dated **January 18, 2002**) have not been made part of the permanent records of the United States Patent and Trademark Office (Office) for this application (37 CFR 1.52(a)) because of damage from the United States Postal Service irradiation process. The above-identified papers, however, were not so damaged as to preclude the USPTO from making a legible copy of such papers. Therefore, the Office has made a copy of these papers, substituted them for the originals in the file, and stamped that copy:

### COPY OF PAPERS ORIGINALLY FILED

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If applicant wants to review the accuracy of the Office's copy of such papers, applicant may either inspect the application (37 CFR 1.14(d)) or may request a copy of the Office's records of such papers (*i.e.*, a copy of the copy made by the Office) from the Office of Public Records for the fee specified in 37 CFR 1.19(b)(4). Please do **not** call the Technology Center's Customer Service Center to inquiry about the completeness or accuracy of Office's copy of the above-identified papers, as the Technology Center's Customer Service Center will **not** be able to provide this service.

If applicant does not consider the Office's copy of such papers to be accurate, applicant must provide a copy of the above-identified papers (except for any U.S. or foreign patent documents submitted with the above-identified papers) with a statement that

Art Unit: 1755

such copy is a complete and accurate copy of the originally submitted documents. If applicant provides such a copy of the above-identified papers and statement within **THREE MONTHS** of the mail date of this Office action, the Office will add the original mailroom date and use the copy provided by applicant as the permanent Office record of the above-identified papers in place of the copy made by the Office. Otherwise, the Office's copy will be used as the permanent Office record of the above-identified papers (*i.e.*, the Office will use the copy of the above-identified papers made by the Office for examination and all other purposes). This three-month period is not extendable.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: no literal antecedent basis is seen for the phrase "comprising 1000 parts by weight water" in claim 6.

The examiner suggests the incorporation of this phrase into the specification or the claims amended accordingly.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 and 7-22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP60/258541.

JP60/258541 teaches a photosensitive material having at least one photosensitive layer comprising a metallic oxide such as titania or alumina having a

Art Unit: 1755

particle size of 10-700 nm (i.e. ceramic nanoparticle), a hydrophilic binder such as gelatin (i.e. film-forming hydrophilic colloid) and a compound to swell the base. See the abstract. The photosensitive material as taught by JP60/258541 appears to anticipate the present claims.

6. Claims 1-4 and 7-22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP63/287849.

JP63/287849 teaches a layer of a silver halide photosensitive layer that comprises an electroconductive metal oxide such as titania or alumina having a particle size of 10-700 nm (i.e. ceramic nanoparticle) and a hydrophilic binder such as gelatin (i.e. film-forming hydrophilic colloid). See the abstract. The photosensitive material as taught by JP63/287849 appears to anticipate the present claims.

7. Claims 1-4, 7-15 and 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP56/143431.

JP56/143431 teaches a photographic material having at least one conductive layer comprising microparticles of a metallic oxide such as titania or alumina having a particle size below 500 nm (i.e. ceramic nanoparticle) and a hydrophilic binder such as gelatin (i.e. film-forming hydrophilic colloid). See the abstract. The photographic material as taught by JP56/143431 appears to anticipate the present claims.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1755

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6, 8-15 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bock et al.

Bock et al. teach a coating composition having improved scratch resistance comprising 0.5-25 wt% of nanoparticles having a particle size below 200 nm such as aluminum oxide and titanium dioxide suspended in water and a water-soluble binder such as acrylic polymers. See col. 2, lines 45-49, col. 3, lines 23-50, col. 4, lines 8-33, col. 5, lines 10-47, col. 6, lines 12-31, example 1 and claims 1, 2 and 10. Bock et al. fails to specifically exemplify the use of alumina and titania as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific alumina and titania as claimed by applicants as Bock et al. also discloses the use of these metal oxides but fails to show an example incorporating them.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is 703-308-3745. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the


Art Unit: 1755

organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK  
July 24, 2003